

REMARKS

1. The Examiner has objected to the drawings under 37 CFR 1.83(a).

Claims 1, 5 and 8 have been amended to eliminate the reference to a "print media supply" or a "supply".

The "hard copy apparatus structure" is recited as element 300 in paragraph XXV of the specification and is shown in Figure 3.

A proposed amended Figure 3 is submitted with this paper. The proposed change shows the light emitter 121 and the light detector 122 as called out in claims 9 – 13. No new matter is added. The amendment is consistent with the description found at paragraph XXIII which provides:

"The optical sensing device, or transmissive type "paper sensor," 105 can be of a type that is commercially available, e.g., model SFH9500 manufactured by Siemens corp. The Walker et al., *supra*, devices describe a blue light device which can also be employed; e.g., model GP1S522 manufactured by Sharp Electronic Components, Sharp corp. Such sensors have a light emitter and light detector as would be known in the art."

Application paragraph XXIII.

2. The Examiner has objected to Claims 8 and 12 -13 because of the following informalities:

a) At claim 8, line 15, "a known print medium" after "stacked sheets of" should be changed to -the known print medium -. Appropriate correction has been made. No new matter is added.

b) At claim 12, line 4, "a paper" before transport path" should be changed to – the print media-. Appropriate correction has been made. Claim 12 has been amended to recite:

the light emitter mounted to a transport, the transport powered for scanning said beam across the paper path wherein a reflective element and absorptive element are mounted transverse to said paper path such that the sheet of print media passes between said light emitter and said reflective element and absorptive element.

No new matter is added.

c) At claim 12, line 4 "of said print media" after "transport path" should be removed. Appropriate correction has been made. Claim 12 has been amended to recite:

the light emitter mounted to a transport, the transport powered for scanning said beam across the paper path wherein a reflective element and absorptive element are mounted transverse to said paper path such that the sheet of print media passes between said light emitter and said reflective element and absorptive element.

No new matter is added.

d) At claim 13, line 3, "light beam" after "projecting" should be changed to –the light beam -. Appropriate correction has been made. No new matter is added.

3. The Examiner has rejected Claims 1, 5 - 8, 12 and 13 under 35 U.S.C. 112, second paragraph.

a) In claim 1, the phrase "an apparatus structure" has been deleted. Appropriate correction has been made. No new matter is added.

b) In claim 5, line 6, the phrase, "a print medium", has been deleted. Appropriate correction has been made. No new matter is added.

c) In claim 6, the phrase "the light" has been amended to read "the transmissive light". Appropriate correction has been made. No new matter is added.

d) In claim 6 the second occurrence of the phrase "a second type of print medium" has been amended to read "the second type of print medium", to make it clear that only one second type of print medium, in addition to the print medium of Claim 5, is being characterized according to the method of the invention. No new matter is added.

e) In claim 7, line 2, "a print medium" has been amended to read "the third print medium" consistent with the recitation of "a third print medium" added at line 3, clarifying that a third type of print medium in addition to the print medium of Claim 5 and the second type of print medium of Claim 6, is being characterized according to the method of the invention. Appropriate correction has been made. No new matter is added.

f) In claim 8, "the hard copy apparatus structure" has been amended to read "a hard copy apparatus structure". Appropriate correction has been made. No new matter is added.

g) In claim 12, lines 5 – 8, "a reflective element and absorptive element" has been amended to read "the reflective element and a non-reflective element" consistent with the recitation of "a reflective element and a non-reflective element" in claim 9. Appropriate correction has been made. No new matter is added.

h) In claim 13, the phrase "the print media" has been deleted. Appropriate correction has been made. No new matter is added.

4. The Examiner has rejected Claims 1 - 13 under 35 U.S.C. 102(b) as being anticipated by Lisnyansky et al. (Patent No. US 5,047,652).

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* basis for rejection of Claims 1 - 13 under 35 U.S.C. 102(b) as being anticipated by Lisnyansky et al.

Applicant has amended independent Claims 1, 5, 8 and 9 to include a reference to a hard copy apparatus structure including a reflective element and a non-reflective element positioned in a print media transport path.

Claims 1, 5 and 8 now provide the following limitation:

"transporting a print medium along a paper path of a hard copy apparatus structure including a lower paper guide including a reflective element and a non-reflective element the lower paper guide positioned subjacently to a transmissive sensor".

Similarly, Claim 9 now includes the following limitation:

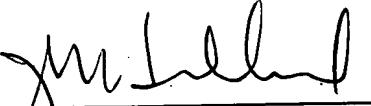
"a reflective element and a non-reflective element mounted to an apparatus structure including a lower paper guide positioned in the paper path, the reflective element and the non-reflective element aligned with the light emitter; such that said light beam is received by the reflective element and the non-reflective element after passing through the sheet of print media in said paper path".

To constitute a "description" of a patented invention within the meaning of 35 USC § 102(b) the prior publication must describe the invention as claimed in full, clear and exact term so as to allow a person skilled in the art to practice the invention. Vague and general representations are not sufficient to support a defense of anticipation under the law. *Ballantyne Instruments & Electronics, Inc., vs. Wagner*, 345 F.2d 671, 673-74, 145 USPQ 408 (1965). In a rejection based on 35 U.S.C. §102, an applied reference must teach every aspect of the invention, either implicitly, or explicitly. MPEP 706.02. For these reasons, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case for rejection under 35 U.S.C. §102(b).

Lisnyansky et al. do not teach a reflective element and a non-reflective element mounted to an apparatus structure including a lower paper guide positioned in the print media transport path, but rather a backing roll rotating with a circumferential velocity that substantially equals a velocity of a web, the rotating roll having a surface which comprises at least one optical standard, said roll positioned such that a circumferential portion of said surface contacts the back web surface where said at least one characteristic is to be measured and the web curving around said circumferential portion.

Applicant respectfully submits that the rejection of Claims 1, 5, 8 and 9 together with Claims 2 – 4, which depend from Claim 1, Claims 6 and 7, which depend from Claim 5, Claims 10 – 13, which depend from Claim 9 should be withdrawn and Claims 1 – 13 should be passed on for allowance.

5. Applicant believes the application is in condition for allowance and respectfully requests the same. If the Examiner is of a differing opinion he/she is hereby requested to conduct a telephonic interview with the undersigned attorney.



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